

Remarks

This Application has been carefully reviewed in light of the Office Action mailed January 2, 2004. Applicants appreciate the Examiner's consideration of the Application. Since Applicants believe all claims are allowable without amendment, no amendments have been made. Applicants respectfully request reconsideration and allowance of all pending claims.

The Claims are Allowable over *Sekitani*

The Examiner rejects Claims 1-4, 6-7, 9-12, 14-15, 17-20, 22-23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Application Publication 2002/0004761 by Sekitani ("*Sekitani*"). Applicants respectfully disagree.

A. The *Sekitani* Reference

Sekitani discloses a system that allows a user to identify parts for production machines. (Abstract; Paragraph [0007]-[0008]) Part information means 13 transmits identification information on a production machine to database 1. (Paragraphs [0009], [0051]) In response, database 1 extracts information on parts for the identified production machine and transmits the extracted information as machine-specific part information 6 on the identified production machine. (Paragraphs [0009], [0053]) The user accesses machine-specific part information 6 to retrieve the appropriate parts for the identified production machine. (Paragraphs [0010], [0054]-[0055]) Machine-specific part information 6 includes a part table 31, an assembly drawing 32, and an electric-circuit diagram 33. (Paragraph [0039]) Part table 31, assembly drawing 32, and electric-circuit diagram 33 are linked so that when a portion of part table 31 is specified, the corresponding drawing 32 and diagram 33 are displayed. (Paragraph [0042]) Similarly, when a predetermined portion of drawing 32 or diagram 33 is specified, the corresponding portion of part table 31 is displayed. (Paragraph [0042])

B. No *Prima Facie* Case of Obviousness

In contrast to the system disclosed in *Sekitani*, independent Claim 1 of the present Application recites:

A computer-implemented method for *mapping between part numbers that are based on different part numbering schemes*, comprising:

receiving a first part number associated with an item, the first part number associated with the item being defined according to a first part numbering scheme;

searching a database for *one or more second part numbers* that are associated with the item and also *cross-referenced to the first part number* associated with the item, the one or more second part numbers associated with the item being *defined according to one or more corresponding second part numbering schemes*; and

in response to identifying the one or more second part numbers associated with the item, searching a database for *a third part number* that is associated with the item and also *cross-referenced to at least one second part number* associated with the item, the third part number associated with the item being *defined according to a third part numbering scheme, the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.*

Sekitani fails to disclose, teach, or suggest these limitations. First, *Sekitani* fails to disclose, teach, or suggest any mapping between part numbers, much less "*mapping between part numbers that are based on different part numbering schemes*" as recited in Claim 1. The Examiner appears to acknowledge this deficiency of *Sekitani*. (See Office Action, Page 3) Second, *Sekitani* fails to disclose the details of the part number mapping technique recited in Claim 1.

For example, *Sekitani* fails to disclose, teach, or suggest:

searching a database for *one or more second part numbers* that are associated with the item and also *cross-referenced to the first part number* associated with the item, the one or more second part numbers associated with the item being *defined according to one or more corresponding second part numbering schemes*

Sekitani fails even to disclose, teach, or suggest one or more second part numbers associated with the item, much less one or more such second part numbers being "*cross-referenced to the first part number associated with the item*" and "*defined according to one or more corresponding second part numbering schemes*," as recited in Claim 1. *Sekitani* therefore

necessarily fails to disclose, teach, or suggest "searching a database for" the one or more second part numbers recited in Claim 1.

As another example, *Sekitani* fails to disclose, teach, or suggest:

in response to identifying the one or more second part numbers associated with the item, searching a database for ***a third part number*** that is associated with the item and also ***cross-referenced to at least one second part number*** associated with the item, the third part number associated with the item being ***defined according to a third part numbering scheme, the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item.***

Since *Sekitani* fails to disclose the recited one or more second part numbers, *Sekitani* also necessarily fails to disclose, teach, or suggest a third part number associated with the item, much less such a third part number being "***cross-referenced to at least one second part number associated with the item,***" being "***defined according to a third part numbering scheme,***" and to which the first part number associated with the item is mapped "***through the at least one second part number associated with the item,***" as recited in Claim 1.

As noted above, the Examiner appears to acknowledge that *Sekitani* fails to teach "***mapping between part numbers that are based on different part numbering schemes***" as recited in Claim 1. (See Office Action, Page 3) Applicants respectfully note that this concept is specifically recited in the preamble of Claim 1 and specifically recited in further detail in the final clause of Claim 1 ("***the first part number associated with the item being mapped to the third part number associated with the item through the at least one second part number associated with the item***"). Thus, the limitations acknowledged to be missing from *Sekitani* are fundamental to Claim 1 and further reveal the glaring deficiencies of *Sekitani* as a reference against Claim 1, discussed above. Applicants respectfully submit that the Examiner's conclusory assertion that it would have been obvious to modify the teachings of *Sekitani* to arrive at Applicants' invention is entirely insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a) under the M.P.E.P. and the governing Federal Circuit case law.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. The teaching, suggestion, or motivation for the modification or combination and the reasonable expectation of success must both be found in the prior art and cannot be based on an applicant's disclosure. *See Id.* (citations omitted). "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. § 2143.01. Even the fact that references *can* be modified or combined does not render the resultant modification or combination obvious unless the prior art teaches or suggests the desirability of the modification or combination. *See Id.* (citations omitted). Moreover, "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432. *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (holding a *prima facie* case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted).

The Examiner's conclusion that it would have been obvious to those of ordinary skill in the art to modify the system disclosed in *Sekitani* to arrive at the invention recited in Claim 1, including each limitation recited in Claim 1, is not supported by any teaching, suggestion, or motivation in *Sekitani*. Applicant respectfully submits that the Examiner's purported motivation for modifying *Sekitani* falls well short of the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law. Since the Examiner has not provided a sufficient teaching, suggestion, or motivation in the prior art, the Examiner's has not made a proper *prima facie* case of obviousness and the rejection should be withdrawn.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 1 and its dependents. Independent Claims 9, 17, and 25 recite limitations substantially similar to those recited in independent Claim 1. For at least the same reasons, Applicants respectfully request reconsideration and allowance of independent Claims 9, 17, and 25 and their dependents.

All of Applicants' arguments are without prejudice or disclaimer. Applicants have merely discussed example deficiencies of *Sekitani* and example reasons why the Examiner has not made a *prima facie* case of obviousness under the M.P.E.P. and governing Federal Circuit cases. Other distinctions and reasons may exist and Applicants reserve the right to discuss additional distinctions and reasons in a later Response or on Appeal, if appropriate. Applicants respectfully submit that the example distinctions and reasons discussed above are clearly sufficient to overcome the obviousness rejections.

Allowed and Allowable Claims

Applicants appreciate the Examiner's allowance of Claim 26 and the Examiner's acknowledgement that Claims 5, 8, 13, 16, 21, and 24 contain allowable subject matter.

Pursuant to 37 C.F.R. § 1.104, Applicants respectfully issue a statement commenting on the Examiner's reasons for allowance. Applicants respectfully disagree with the Examiner's reasons for allowance to the extent that they are inconsistent with applicable case law, statutes, and regulations. Furthermore, Applicants do not admit to any characterization or limitation of the claims, particularly any that are inconsistent with the language of the claims considered in their entirety and including all of their constituent limitations, or to any characterization of a reference by the Examiner.

Conclusion

Applicants have made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicants respectfully request full allowance of all pending claims.

If the Examiner believes a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

Applicants believe no fee is due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicants



Christopher W. Kennerly
Reg. No. 40,675

Correspondence Address:
2001 Ross Avenue, 6th Floor
Dallas, Texas 75201-2980
(214) 953-6812

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